

REMARKS

The previous amendment and response filed May 30, 2007 to the Final Rejection dated April 19, 2007 was not entered. Therefore, this amendment and response repeats the amendments to the claims of the previous response. As a result, claims 1, 25, 35-38, 41, 49, 55, and 57 are amended. Entry, reconsideration and allowance of claims 1-38 and 41-57 is respectfully requested in light of the accompanying Request for Continued Examination and in view of the following remarks:

Response to Rejection of Claims under 35 U.S.C. §112

Claims 1-37 stand rejected Under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for containing the language "and/or". Applicant submits that this rejection is defective and should be withdrawn.

MPEP 706.03(d) discusses claim rejections under 35 USC 112, second paragraph. While many examples of indefinite claim language are given in this section of the MPEP, no mention is found of the phrase "and/or" as being indefinite. It is submitted that the phrase "and/or" is NOT indefinite. The plain meaning of the phrase means A and B or the phrase means A or B. As an example to the validity of this argument, a quick search of the USPTO website revealed that the USPTO has issued 135,427 patents between 1976 and July 10, 2007 with the phrase "and/or" in the claims. In fact, the search showed that 185 patents issued on July 10, 2007 alone with the phrase "and/or" in the claims. Therefore, it is submitted that the phrase "and/or" is NOT indefinite and this rejection should be withdrawn.

Response to Rejection of Claims under 35 U.S.C. §103

Claims 1-4, 6, 7, 12, 21-24, 25, 27 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al. (U.S. Patent No. 6,182,048) (Osborn hereinafter) in view of Bakoglu et al. (U.S. Patent No. 5,983,369) (Bakoglu hereinafter). These rejections are not applicable to the rejected claims.

Amended claim 1 is a method of upgrading an existing warranty of a computer system including a plurality of components in a configuration, the method comprising: receiving, by a warranty processor, a warranty upgrade request from the computer system to upgrade the existing warranty, the warranty upgrade request including configuration information for the computer system including type, revision and serial number of each field replaceable unit (FRU)

in the configuration; determining, by the warranty processor, a warranty upgrade price dependent on the configuration information in the warranty upgrade request, and/or warranty time remaining and/or reliability of components in the configuration and/or age of components in the configuration and/or replacement cost of components in the configuration; communicating the warranty upgrade price to the computer system; and sending a warranty authorization to the computer system after acceptance of price to upgrade the warranty.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, at least do not teach a method of upgrading an existing warranty of a computer system to upgrade the existing warranty, as required by amended claim 1. To the contrary, Osborn is limited to **NEW vehicle insurance policies**, NOT upgrading existing computer system warranties. See entire patent. Additionally, Bakoglu relates to online computer support systems. See Background.

Referring to Osborn, the rejection states in page 3, paragraph 3 of the Office Action that "Osborn discloses a method of upgrading a warranty including a plurality of components in a configuration." However it is apparent from a review of Osborn that Osborn does NOT relate to product warranties or warranty upgrades. It is even conceded by the Examiner that "Osborn fails to disclose a warranty upgrade request for a computer system including configuration information for the components of the computer system." Office Action Page 3, lines 20-21. Rather, Osborn relates to *vehicle insurance*, commonly known as hazard insurance, not a product warranty. In addition, to NOT disclosing a warranty as recited in the pending claims, Osborn does not even contain the word "upgrade" in the patent. Furthermore, The only uses of

the term "computer" in Osborn are found in Figure 1 (computer 12), Col. 2, lines 63 and 65, Col. 3, line 15, and Col. 4, line 45, only dealing with the workstation for an operator to calculate insurance pricing, NOT as an object of the warranty upgrade. Therefore, it is impossible for Osborn to disclose or teach a computer warranty upgrade, as recited in the pending claims.

Referring now to Bakoglu, the rejection states on page 4 that, "[i]t would be obvious to one of ordinary skill in the art at the time of the invention to configure the interrogation software to invalidate a registered warranty when and unwarranted change in the configuration of the computer system is detected, thus requiring warranty upgrade prior to use." This statement is respectfully traversed as being nonsensical. Bakoglu makes NO reference to invalidating *anything*, including a warranty. Furthermore, a quick search of the specification of Bakoglu reveals that Bakoglu is NOT disclosing warranty upgrades. For example, the only references found relating to the term "warranty" in Bakoglu are found in the Abstract, Col. 13, line 39, and claim 14. The reference in the Abstract relates to warranty information that is tracked and indexed, (i.e. nothing about a product warranty upgrade). The references in Column 13 and claim 14 relate to warranty validation. Again, nothing about a product warranty upgrade. Furthermore, the only references in the specification of Bakoglu relating to "upgrades" are found in Col. 1, line 53; Col. 8, line 15; Col. 13, lines 40 and 54; and claims 17 and 20. Each of these references relate to *hardware* and/or *software* upgrades, NOT warranty upgrades.

Even more, the rejection states on page 4 that "it would have been obvious to one of ordinary skill in the art to apply the vehicle warranty upgrade and pricing method of Osborn [which, as shown above, is NOT what Osborn discloses] to a computer system because receiving configuration information for the computer system, including information on user field replaceable units (FRU's) in the configuration, such information to be used for a variety of services, including warranties, is well known in the art as evidenced by Bakoglu." Once again, this rejection is traversed as an improper rejection because, as shown above, Bakoglu does NOT disclose updating a warranty. Still more, the pending claims of the *present* application do not recite "receiving configuration information for the computer system."

In view of the foregoing, it is apparent that each of the elements in the pending claims are not found in the references and these rejections are improper. Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with

respect to amended claim 1, and a rejection under 35 U.S.C. §103(a) is not applicable and should be withdrawn.

Claims 2-4, 6, 7, 12, 21-24 each depend directly or indirectly from independent claim 1. As shown above, independent claim 1 is allowable. Thus, these claims are allowable as depending from an allowable claim. Independent claims 25, 35, and 36 each relate to upgrading an existing warranty of a computer system similar to independent claim 1. As shown above, the cited references do not teach alone or in combination upgrading an existing computer system warranty. Therefore, these rejections are improper and should be withdrawn. Claim 27 depends from independent claim 25 and is allowable as depending from an allowable claim.

Claims 37, 38, 41, 49, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al. (U.S. Patent No. 6,182,048) (Osborn hereinafter) in view of Bakoglu et al. (U.S. Patent No.5,983,369) (Bakoglu hereinafter), and further in view of Johnson (U.S. Patent No. 6,904,592) (Johnson hereinafter). Each of these claims are independent claims relating to upgrading an existing warranty of a computer system similar to independent claim 1. As shown above, Osborn and Bakoglu do not teach alone or in combination upgrading an existing computer system warranty. Additionally, it is submitted that Johnson relates to software upgrades, NOT warranty upgrades. Therefore, these rejections are improper and should be withdrawn.

Claims 8, 11, 13-17, 20, 28, 31-34, 42, 45-48, 50-51 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al. (U.S. Patent No. 6,182,048) (Osborn hereinafter) in view of Bakoglu et al. (U.S. Patent No.5,983,369) (Bakoglu hereinafter) and further in view of Olarig et al. (U.S. Patent No. 6,032,257) (Olarig hereinafter), and further in view of Johnson (U.S. Patent No. 6,904,592) (Johnson hereinafter). Each of these claims depend directly or indirectly from one of the pending independent claims. As shown above, the pending independent claims are allowable. Thus, these claims are allowable as each depending from an allowable claim.

Claims 5, 9-10, 26, 29-30, 43-44 and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al. (U.S. Patent No. 6,182,048) (Osborn hereinafter) in view of Bakoglu et al. (U.S. Patent No.5,983,369) (Bakoglu hereinafter) and further in view of Wallis et al. (U.S. Publication No. 2001/0051884) (Wallis hereinafter), and further in view of Johnson (U.S. Patent No. 6,904,592). Each of these claims depend directly or indirectly from one of the

pending independent claims. As shown above, the pending independent claims are allowable. Thus, these claims are allowable as each depending from an allowable claim.

Claims 18-19 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn et al. (U.S. Patent No. 6,182,048) (Osborn hereinafter) in view of Bakoglu et al. (U.S. Patent No.5,983,369) (Bakoglu hereinafter) and further in view of Olarig et al. (U.S. Patent No. 6,032,257) (Olarig hereinafter) and further in view of Wallis et al. (U.S. Publication No. 2001/0051884) (Wallis hereinafter), and further in view of Johnson (U.S. Patent No. 6,904,592) (Johnson hereinafter). Each of these claims depend directly or indirectly from one of the pending independent claims. As shown above, the pending independent claims are allowable. Thus, these claims are allowable as each depending from an allowable claim.

In addition to the above, the Office Action states on page 28 that "disclosing warranty pricing variables such as the age and mileage, said age variable considered as a measure equivalent to warranty time remaining , and age of components in the configuration; and said mileage variable considered as a measure equivalent to reliability of components in the configuration." These "measure equivalent" statements are respectfully traversed. It is submitted that the disclosure of Osborn is not equivalent to the elements recited in the pending claims. These are materially different factors indicating different characteristics. Therefore these conclusions should be withdrawn.

The amendments are not meant to limit, but rather to further define the scope of the claims. The amendments are supported by the original application.

In light of at least the above, independent claims 1, 25, 35-38, 41, 49, 55, and 57 and their respective dependent claims are submitted to be allowable. Therefore, the allowance of all pending claims is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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